

**REMARKS**

Withdrawal of the final rejection and continued prosecution in light of the current amendments and remarks filed with the concurrent Request for Continued Examination is respectfully requested.

Upon entry of this amendment claims 1-3, 8, and 11-23 will be pending. Claims 12-26 are newly added, and claims 1, 11, 15, and 18 are independent. Support for both the newly added claims, as well as the amended claims, may be found throughout the specification and no new matter has been added. For example, the amendment to claim 1 is supported by the specification at page 3, lines 1-4, and example 1 on page 4. Claims 13-14 are supported by Example 1 page 4, claims 15- 24 are supported by examples 1-6, and page 1, lines 1-2.

With regard to the outstanding 35 USC §103(a) rejection over McGraw (US 4,851,144) and Ward (US RE 33,658), considered separately, or in combination with Smalheer *et al*, the Applicants submit that the invention as presently claimed is not obvious in light of these references. Accordingly, the Applicants request reconsideration and withdrawal of this rejection.

As the Applicants previously noted, McGraw sets out to make lubricants for *refrigeration* compressors that avoid the problem of phase separation of the lubricant from a hydrofluorocarbon or hydrochlorofluorocarbon *refrigerant*. The modification of McGraw for selection of components in the disclosed compositions to avoid the formation of stable emulsions of the lubricant in condensed *water* is not at issue and is not suggested. Therefore, this reference provides no motivation to one skilled in the art to simultaneously select a component (1) and a component (2) to avoid forming an emulsion in water.

Since Ward provides no guidance in selecting the end capped polyalkylene glycols/diester blends of the present invention, or how such compositions would avoid forming emulsions in water, it provides no motivation or reasonable expectation of successfully obtaining the claimed invention. Furthermore, Ward does not disclose lubricants with polyol esters.

Finally, the Applicants note that there is no suggestion to combine Smalheer with either McGraw or Ward, for the reasons relied upon in their previous response. However, even if combined, the claimed invention would still not be obvious.

**CONCLUSION**

For these reasons, it is respectfully submitted that the claims are patentable over the prior art. The Examiner is kindly requested to reconsider and withdraw the rejection of the claims. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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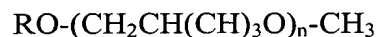
Attorney Reference: 090128/0280189  
Attachment: Appendix

**APPENDIX: VERSION SHOWING CHANGES MADE TO THE APPLICATION**

**IN THE CLAIMS:**

1. (Thrice Amended) A lubricant composition comprising:

(1) 90 to 55 weight percent of a polyalkylene glycol having the formula



where R is an alkyl group with [1-4] 1 to 15 carbon atoms and  $n = 1$  to 35; and

(2) 10 to 45 weight percent of a polyol [an] ester [selected from the group consisting of a polyol ester, an aliphatic diacid ester, an aromatic diacid ester or a trimellitate.] ;

wherein said lubricant does not form a stable emulsion with water.

*End of Appendix*